

### **REMARKS**

Claims 57-59 are pending in the instant application after entry of the instant amendment. Reconsideration of the claims in light of the amendments presented above and the remarks presented below is respectfully requested. Support for Claims 58 and 59 can be found throughout the specification and drawings, particularly at pages 16 and 27 of the specification

#### **Priority**

The priority data has been amended in the specification to ensure consistency with the application as filed. Entry of this amendment is respectfully requested.

#### **Claim Objections**

Claims 49-51 stand objected to under 37 CFR 1.75(c), as being improperly dependent for failing to further limit the subject matter of a previous claim. As Claims 49-51 have been canceled by the instant amendment, withdrawal of this rejection is respectfully requested.

#### **Claim Rejections Under 35 U.S.C. § 102**

Claims 43-47 and 52-55 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Number 6,541,617 to Bamdad, et al. ("Bamdad"). As Claims 43-47 and 52-55 are canceled by the instant amendment, withdrawal of this rejection is respectfully requested.

Claim 57 stands rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Number 6,177,250 to Meade, et al. ("Meade"). In particular, the Examiner asserts that Meade teaches hybridization complexes having first and second ETMs with first and second redox potentials.

For an anticipation rejection under 35 U.S.C. §102 to be proper, a single reference must expressly or inherently disclose each and every element of a claim. In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); MPEP § 2131 (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Each of the pending claims, as currently amended, include at least three different ETMs (one electrode and two label probes each comprising an ETM) wherein each ETM has a different redox potential. Meade does not disclose such a system. As Meade does not disclose each an every element of the rejected claims, Meade cannot anticipate the claims and withdrawal of the rejection under 35 U.S.C. § 102 is respectfully requested.

Claims 43-48, 50, and 53-57 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Number 6,686,150 to Blackburn, et al. ("Blackburn"). As to Claims 43-48, 50, and 53-56, each of these Claims have been canceled by the instant amendment and thus withdrawal of the rejection to each of those claims is respectfully requested. As to Claim 57, the Examiner asserts that the use of multiple label probes that have the same ETM and are complementary to all or part of a recruitment linker anticipates the instant invention.

For an anticipation rejection under 35 U.S.C. §102 to be proper, a single reference must expressly or inherently disclose each and every element of a claim. In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); MPEP § 2131 (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Each of the pending claims, as currently amended, include at least three different ETMs (one electrode and two label probes each comprising an ETM) wherein each ETM has a different redox potential. Blackburn does not disclose such a system. As Blackburn does not disclose each an every element of the rejected claims, Blackburn cannot anticipate the claims and withdrawal of the rejection under 35 U.S.C. § 102 is respectfully requested.

**Claim Rejections Under 35 U.S.C. § 103**

Claim 56 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Bamdad in view of Meade. As Claim 56 is canceled by the instant amendment, withdrawal of this rejection is respectfully requested.

Claim 48 stands rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Number 5,185,243 to Ullman, et al. ("Ullman") in view of Meade. As Claim 48 is canceled by the instant amendment, withdrawal of this rejection is respectfully requested.

Claims 49-50 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Baner, et al., Nucleic Acids Res., 26:5073-5078, 1998) in view of Meade. As Claims 49-50 are canceled by the instant amendment, withdrawal of this rejection is respectfully requested.

**Double Patenting**

Claims 49-51 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claims 1, 9-10 of Blackburn. As Claims 49-51 are canceled by the instant amendment, withdrawal of this rejection is respectfully requested.

Serial No.: 09/626,096  
Filed: July 26, 2000

**CONCLUSION**

Please direct further questions in connection with this petition to the undersigned  
at (415) 781-1989.

Respectfully submitted,  
DORSEY & WHITNEY LLP

Dated: 6/14/00

**Customer No.: 32940**

Four Embarcadero Center  
Suite 3400

San Francisco, CA 94111-4187

Telephone: (415) 781-1989

Facsimile: (415) 398-3249

By: SA

Steve P. Lendaris, Reg. No. 53,202 for

Robin M. Silva, Reg. No. 38,304

*Filed Under 37 C.F.R. § 1.34(a)*